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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,723	10/29/1999	CLAUDE HOPE	BAL6019P0011	6250

32116 7590 12/29/2005

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

EXAMINER

HWU, JUNE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/429,723

Applicant(s)

HOPE ET AL.

Examiner

June Hwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-56,59-65,73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-56,59-65,73 and 74 is/are rejected.
- 7) ☒ Claim(s) 41,43,51,59 and 61 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The amendment filed October 18, 2005 has been acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

Status of the Claims

3. Claims 1-32, 57, 58, 66-72, 75 and 76 have been cancelled. Claims 41-56, 59-65, 73 and 74 are pending.

Drawings

4. The Supervisory Patent Examiner has granted the petition for drawings filed on October 18, 2005.
5. The rejection of claims 57, 59 and 60-65 under 35 U.S.C. 102(b) is withdrawn in view of Applicants' amendment dated October 18, 2005.
6. The rejection of claims 48-54 under 35 U.S.C. 112(2nd paragraph) is withdrawn in view of Applicants' amendment dated October 18, 2005.

Objections to the Specification

7. The disclosure is objected to because of the following informalities: The deposit information on page 2 of specification amendment dated October 18, 2005 does not include the date of the deposit. See 37 CFR 1.809(d)(2). Appropriate correction is required.

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Furthermore, Applicants must supply an agreement from the depository to comply with the terms and conditions applicable to deposits for patent purposes. See CFR 1.803(a)(2) and (b).

Objections to the Claims

8. Claims 41, 43, 51, 59 and 61 are objected to because they are missing an article at the beginning of each claim.

Claim Rejections - 35 USC § 112

9. Claims 49-56 and 73-74 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are drawn to *Eustoma* plants and methods of producing *Eustoma* plants that involve an indeterminate number of generations and parent plants of unknown function and number, wherein it remains unclear what the identity of the plants in each of the steps would be, much less what the resultant product plant would be. Neither the plants required by each of the steps, nor the plants that are produced by the process are defined by genomic structure or by phenotypic characteristics, and therefore, the claimed invention lacks an adequate written description.

See *University of California v. Eli Lilly*, 119 F.3d 1567, 43 USPQ 2d 1405 (Fed. Cir. 1997), where it states:

[a] written description of an invention involving a chemical genus, like a description of a chemical species, "requires a precise definition, such as by structure, formula, [or] chemical name," of the claimed subject matter sufficient to distinguish it from other materials.

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Therefore, given the lack of written description in the specification with regard to the structural and physical characteristics of the claimed compositions, it is not clear that Applicant was in possession of the genus claimed at the time this application was filed.

10. Claims 41-56 and 73-74 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A full review of the specification indicates that *Eustoma* inbred 752 and *Eustoma* hybrid 3087 are essential to the operation of the claimed invention. A search of *Eustoma* inbred 752 and *Eustoma* hybrid 3087 indicates that they are novel and unobvious.

Claims 49-54 are drawn to a genus of *Eustoma* hybrids that have *Eustoma* inbred 752 as one parent. The specification indicates that Applicant intends to deposit *Eustoma* inbred 752, which would describe *Eustoma* inbred 752. The claimed hybrids have one half of the genome of *Eustoma* inbred 752. The claimed hybrids will not have the same morphological and physiological characteristics as 752. *Eustoma* inbred 752 can be crossed with any other inbred *Eustoma* plant to produce the claimed hybrids. The claimed hybrids then will express a combination of morphological and physiological characteristics that are different from each other, and which are also different from those expressed by 752. The specification does not correlate any genes of 752 with any of the traits that it expresses. Thus, the description of 752 does not provide any information concerning the morphological and physiological characteristics, or the structure or function, of hybrid plants that have 752 as one parent.

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The only hybrid *Eustoma* plant reduced to practice is *Eustoma* hybrid 3087. The description of 3087, however, does not provide any information concerning the description of any other hybrid. There is no evidence on the record of any relationship between the structure of the complete genome of any hybrid and the complete genome of any other hybrid. Hybrids produced by crossing 752 with other, distinct *Eustoma* plants would, of course, produce plants that do not express the same traits as 3087.

In view of these considerations, a person of skill in the art would not have viewed the teachings of the specification as sufficient to show that the Applicants were in possession of the claimed genus of hybrid seeds and plants produced therefrom.

Claims 55-56 and 73-74 are drawn to a genus of methods of using *Eustoma* inbred 752 or *Eustoma* hybrid 3087 in a plant breeding program, including in any of the following techniques: recurrent selection, backcrossing, and pedigree breeding. None of the steps of and none of the other materials used in the techniques of the techniques are described. The specification does not describe at what other *Eustoma* plants 752 and 3087 are crossed with, how many other *Eustoma* plants 752 and 3087 are crossed with, or how many times *Eustoma* plants 752 and 3087 are crossed with other plants. The specification does not describe the structure or function of the other plants. The specification does not describe the materials used in recurrent selection, backcrossing, and pedigree breeding and when and how are they used in the method.

Because the all the starting materials and method steps are not described, the genus of methods of using *Eustoma* inbred 752 or *Eustoma* hybrid 3087 in a plant breeding program is likewise not described, and the specification fails to provide an adequate written description of the claimed invention.

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11. Claims 41-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the seed claimed is essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If a seed is not so obtainable or available, a deposit thereof may satisfy the requirements of 35 U.S.C. 112. The specification does not disclose a repeatable process to obtain the exact same seed in each occurrence and it is not apparent if such a seed is readily available to the public. It is noted that Applicants intend to deposit seeds of *Eustoma* 752 at the ATCC, but there is no affidavit or declaration by the Applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the seeds will be irrevocably and without restriction or condition released to the public upon the issuance of a patent would satisfy the deposit requirement made herein.

12. Claims 55-56 and 73-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Dependent claims are included in all rejections.

Claims 55 and 73 are indefinite because there are no clear positive method steps. The method step "employs a *Eustoma* plant" does not recite clearly defined positive method steps. It is unclear what method of breeding would be incorporated and what parent plants would be used for the cross.

Claims 56 and 74 are indefinite because the starting materials and method steps for each of "recurrent selection", "backcrossing" and "pedigree breeding" are not defined. It is

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unclear for each what steps they comprise, how many generations of crosses would be involved and what parent plants would be used in each cross. Additionally, words appear to be missing between "selected" and "recurrent" in line 2

13. Claims 41-54 are free of the prior art. The closest prior art for inbred 752 is the *Eustoma* 'Little Belle Blue' taught by Harbaugh et al (HortScience 31(6), 1996). *Eustoma* 752 differs from 'Little Belle Blue' in plant height (see Table 1). 'Little Belle Blue' has a plant height of 22 cm while 752 has a height of 12 cm.

Claims 59-65 and 73-74 are free of the prior art. The closest prior art for line 3087 is the *Eustoma* plants taught by Harbaugh et al (HortScience 31(6), 1996). *Eustoma* 3087 differs from 'Florida Blue' in plant height and flower color. 'Florida Blue' has a plant height of 38 cm with violet-blue petal and white band at the base of the petal ((page 1057, column 3) while 3087 has a height of 30 cm and deep blue color with a lighter blue center.

Conclusion

14. No claims are allowed.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

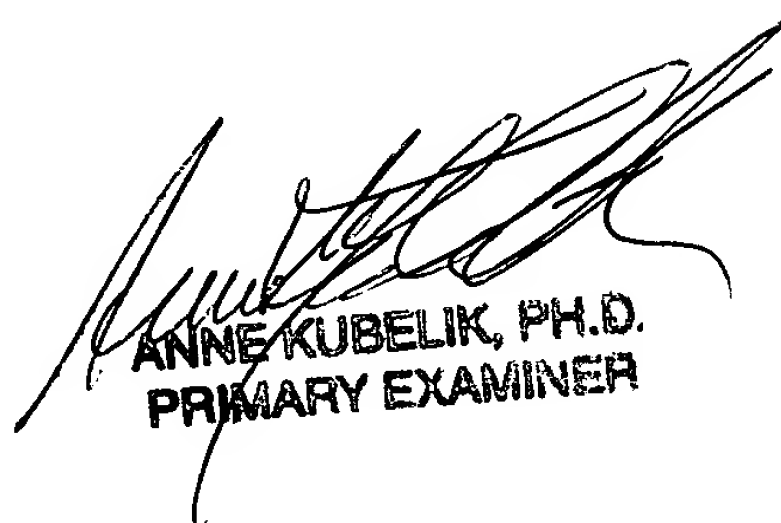
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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June Hwu

December 21, 2005



ANNE KUBELIK, PH.D.
PRIMARY EXAMINER